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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/578,528 | 05/08/2006 | Yuichi Ozeki | 062492 | 9482 |
| 38834 7590 07/24/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036 | | | | |
| EXAMINER | | | | |
| MALEKZADEH, SEYED MASOUD | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1791 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 07/24/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,528

Applicant(s)

OZEKI ET AL.

Examiner

SEYED M. MALEKZADEH

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CIS-100)
- Paper No(s)/Mail Date 05/08/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Double Patenting

Non-statutory

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 12-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6 of the U.S. Patent No. 7,132,072. Although the conflicting claims are not identical, they are not patentably distinct from each other because both of the applications intend to limit a method for manufacturing a molding article having a core using compression molding apparatus comprising an upper punch and a lower punch which are arranged in the vertical direction of a die. Further, claim 6, lines 2-6 of U.S. Patent No. 7,132,072, recites "an outer layer molding step that includes, with the lower center punch being in a lowered position, supplying molding material for the outer layer into outer layer spaces defined by the lower center punch and the lower outer punch", therefore, it would have been obvious that a tip of the lower center punch could take a protruding position from a tip of the lower outer punch in the step of supplying and filling the molding material for the outer layer. Also, claim 6, lines 33-37 of U.S. Patent No. 7,132,072 recites "compressing the molding material for the outer layer with a second molded portion of the outer layer and the cores to mold the whole of the outer layer and the cores by engaging the upper and the lower punches." therefore, it would have been obvious that the tips of the lower center punch and the lower outer punch could be aligned to each other in the step of the compression molding of the whole molding article, as claimed in claims 1 and 12

Therefore, the claims 1-5 and 12-14 of the instant application are broad enough to be covered by the claims 1-3 and 6 of the U.S. Patent No. 7,132,072.

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-12 and 15-22 recite the limitation "the outer layer". There is insufficient antecedent basis for these limitations in the claim because prior to the cited limitations, claims 1 and 12 fail to distinctly define "an outer layer" for the molding article.

With regard to the recitation of claim 7, lines 1-2, "wherein the lower center punch is lowered to align the tip thereof with the tip of the lower center punch", the claim is indefinite and vague because the claim is defining the lower center punch is lowered to be aligned with itself. It is not clear how a lower center punch can be aligned with itself.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo et al (WO 01/98067)

Note: Kondo et al. (US Publication 2004/0113319) is a continuation of Kondo et al. (WO 01/98067). Therefore, for the purpose of the patent examination Kondo et al. (US' 319) has been used as a translation for Kondo et al. (WO 01/98067)

As to claim 1 and 12, Kondo et al (WO '067) teach a method of manufacturing a molding article with a core and an outer layer using a compression molding apparatus comprising an upper punch with a double structure including a center punch (4A) and an outer periphery of the center punch (4B), a lower punch () with a double structure including a center punch (5A) and an outer punch (5B), and a die (3) wherein both of the upper punch (4A and 4B) and the lower punch (5A and 5B) are arranged in the vertical direction of the die (3), respectively, and the outer punches (4B and 5B) surround the outer periphery of the center punches (4A and 5A) and being slidable and capable of a compressing operation. (See claims 1 and 2 and figures 1-5)

Furthermore, Kondo et al (WO '067) teach the method comprises the step of supplying molding material for the core (NP) and molding material for outer layer (OP1 and OP2), respectively, and further, the step of compression molding of the molding material for the core and the molding material for the outer layer, and finally, a compression-molding step of the whole molding with core. (See claim 4). Moreover, the prior art teaches the step of supplying and filling the molding material for the outer layer (OP1 and OP2) is performed when a tip (7A) of the lower center punch (5A) takes a position protruding from a tip (7B) of the lower outer punch (5B) (See figure 3B) and also the step of compression-molding the whole molding article with a core is performed with the tips of the lower center punch (5A) and the lower outer punch (5B) aligned with each other. (See figures 3G - 3H)

Moreover, Kondo et al (WO '067) teaches the core material is supplied into a space defined above the lower center punch (5A) which is surrounded by the lower outer punch (5B) and also a compression molding step of the molding material for the core supplied in the preceding step to mold a core (See figures 1G -1H) and further, an outer layer supply (OP2) step of supplying molding material for the outer layer into a space defined above and around the molding in the die molded in the preceding step until a tip of the lower center punch finally takes a position protruding from a tip of the lower outer punch; and moreover, a whole molding step of compression-molding the core molding and

the molding material for the outer layer with tips of the lower outer punch and the lower center punch aligned with each other. (See figures 3J - 3M).

As to claims 2 and 14, Kondo et al (WO '067) teach the step of supplying the molding material for the outer layer (OP1 or OP2) is not performed prior to the step of supplying the molding material for the core (NP). (See figure 4B, 4K, and 4P)

As to claims 3-5 and 13, Kondo et al (WO '067) teach the step of supplying the molding material consists of two steps including the step of supplying the molding material for the core (NP) and the step of supplying the molding material for the outer layer (OP1 and OP2) wherein the step of supplying the molding material for the outer layer (OP1) is performed prior to the step of supplying the molding material for the core (NP) in such a way that the molding material for the outer layer is supplied to the die, first; then, the molding material for the core (NP) is supplied, and finally, the molding material for the outer layer (OP2) is supplied into the die (3). (See figures 3B, 3E, and 3H)

Kondo et al (WO '067) also teach in the step (3b) which is the outer layer material (OP1) is supplied into the die (5), the lower center punch (5A) is protruded from the lower outer punch (5B), and then in step (3c), the tip (7A) of the lower center punch and the tip (7B) of the lower outer punch are aligned and further, the lower outer punch (5B) and the lower center punch (5A) are

raised, see step (3d), before the step (3e) of supplying the molding material for the core (NP).

Therefore, as to claims 6 and 15, Kondo et al ('067) teach the lower outer punch (5B) is raised to align the tip (7B) of the lower outer punch with the tip (7A) of the lower center punch from the position in which the tip (7A) of the lower center punch is protruded from the tip (7B) of the lower outer punch after the step of supplying the molding material for the outer layer (OP1) and posterior to the step of supplying the molding material for the core (NP). (See figures 3A-3D)

Kondo et al (WO '067) also teach in the step (3b) which is the outer layer material (OP1) is supplied into the die (5), the lower center punch (5A) is protruded from the lower outer punch (5B), and then in step (3c), the lower center punch (5A) is lowered and the tip (7A) of the lower center punch and the tip (7B) of the lower outer punch are aligned, and further, the lower outer punch (5B) and the lower center punch (5A) are raised, see step (3d), before the step (3e) of supplying the molding material for the core (NP).

Therefore, as to claims 7 and 16, Kondo et al ('067) teach the lower center punch (5A) is lowered to align the tip of the lower center punch (7A) with the tip of the lower outer punch (7B) from the position in which the tip of the lower center punch (7A) is protruded from the tip of the lower outer punch (7B) after the step of supplying the molding material for the outer layer (OP1)

posterior to the step of supplying the molding material for the core (NP). (See figures 3A - 3D)

Also, as to claims 8 and 17, Kondo et al ('067) disclose the lower center punch (5A) is lowered while the lower outer punch (5B) is raised to align the tip (7B) of the lower outer punch with the tip (7A) of the lower center punch from the position in which the tip (7A) of the lower center punch is protruded from the tip (7B) of the lower outer punch after the step of supplying the molding material for the outer layer posterior to the step of supplying the molding material for the core.

Moreover, as to claims 9, 18, 21, and 22, Kondo et al ('067) teach the operation of aligning the tips of the lower outer punch and the lower center punch with each other is performed with the upper center punch (7A) and upper outer punch (7B) pressing the molding material in the die (3) after the step of supplying the molding material for the outer layer posterior to the step of supplying the molding material for the core. (See figure 3C)

Furthermore, as to claims 10 and 19, Kondo et al ('067) teach the process of pressing the molding material in the die (3) by the upper center punch (4A) and the upper outer punch (4B) is preformed with the tip (7A) of the lower center punch in the position protruding from the tip (7B) of the lower outer punch after the step of supplying the molding material for the outer layer (OP1) posterior to the step of supplying the material for the core (NP). (See figure 3B)

Moreover, as to claims 11 and 20, Kondo et al ('067) discloses the process of pressing the molding material in the die (3) by the upper center punch (4A) and the upper outer punch (4B) is not performed until the tip of the lower center punch (5A) and the tip of the lower outer punch (5B) become aligned with each other after the step of supplying the molding material for the outer layer (OP1) posterior to the step of supplying the molding material for the core (NP). (See figure 3C)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seyed Masoud Malekzadeh whose telephone number is 571-272-6215. The examiner can normally be reached on Monday – Friday at 8:30 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin, can be reached on (571) 272-1189. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public

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/S. M. M./

Examiner, Art Unit 1791

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791